

REMARKS

Claims 2-5, 9, 13-14 and 16 are canceled.

New claims 21-27 are added. Support for the new claims is provided by various exemplary embodiments of the invention disclosed by the originally-filed application at, for example, pages 4-24 and Figs. 1-23. More specifically, and only as an example, support for new independent claim 21 is provided by various exemplary embodiments of the invention disclosed by the originally-filed application at, for example, page 24, lines 17-25, and including: page 22 and lines 7-18; page 21 and lines 1-14; page 20 and lines 23-35; page 18 and lines 5-25; page 13 and lines 17-35; page 10 and lines 4-16; and Figs. 2, 7-8, 19-20 and 22-23. Dependent claims 22-27 are also disclosed by these specific references to the originally-filed application.

Regarding the rejections, claims 1-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Office alleges respective independent claims 1 and 15 recite to "a narrow range or limitation that falls within [a] broad range or limitation (in the same claim)." (page 2 of paper no. 20090206). A narrowing of a limitation in the same claim is alleged by the Office to be indefinite. However, the MPEP section on which the Office relies is directed to numerical ranges and amount limitations as the title states (see MPEP §2173.05(c)). And yet, the Office states each independent claim 1 and 15 recites to a "generator" and "fluid medium...removing thermal energy" wherein the Office further alleges that "generator" is a narrower statement of the limitation directed to "fluid

medium ... removing thermal energy." Respectfully, these limitations are neither a numerical range nor an amount limitation, and therefore, the rejection instantly fails and should be withdrawn.

Moreover, the Office is respectfully reminded that the MPEP §2173.02 states regarding definiteness: "[d]efiniteness of claim language must be analyzed, not in a vacuum, but **in light of...[(A)] the content of the particular application disclosure...** and [(C)] the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made" (emphasis added). Instantly, it can be stated that "one possessing the ordinary level of skill in the pertinent art" understands that a "fluid medium" and a "generator" are not related as one being narrower than the other. Still further, referring to the originally-filed application as is further required in the definiteness determination, an exemplary "generator" is shown in Figs. 13 and 14 as an apparatus or device. The application explains a generator converts rotating mechanical energy into electrical energy. Additionally, and again referring to the originally-filed application as is required for the definiteness determination, an exemplary "fluid medium" is described as a phase of matter such as "a fluid medium, for example, air and/or a liquid" (page 4 of the originally-filed application). In the context of this application disclosure, no reasonable characterization can be stated that a "generator" is a narrower limitation of a "fluid medium" (air or a liquid) as alleged by the Office. Accordingly, the Office's statement that indefiniteness is created by each of the independent

claims reciting to one limitation being narrower than the other limitation does not exist. Consequently, since the Office's rationale for providing the §112 rejection does not exist, the rejection is improper and must be removed.

Claims 1-20 are definite.

Regarding the rejections based on prior art, claims 1-20 are rejected as being obvious over Murray (US 3,805,082) and further in view of Pleskach et al (US 6,972,955).

Regarding an obviousness rejection, the Office is respectfully reminded that **each and every** limitation or feature of a claim must be shown to be taught or suggested by a combination of art before an obviousness rejection is proper. MPEP §2143.03 requires the "consideration" of every claim feature in an obviousness determination. To determine a claim is obvious, the Office must do more than "consider" each and every feature for the claim. Indeed, each and every feature of a claim must be taught and suggested. As the Board of Patent Appeal and Interferences has confirmed, a proper, post-KSR obviousness determination still requires the Office to make "a searching comparison of the claimed invention-including all its limitations-with the teaching of the prior art." *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court stated in KSR, "**there**

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Regarding independent claim 1, the claim is amended to recite "a **power electronics device** having the capability to modify and convert the electrical power to one or more of **selective** forms." The amendment language is supported by various exemplary embodiments of the invention disclosed by the originally-filed application, for example, page 8, lines 25-35 and page 9, lines 9-30. The combination of art for which the Office relies to reject claim 1, Murray and Pleskach, fail to teach or suggest "a power electronics device" as positively recited by independent claim 1. More specifically, the Office relies on Murray to teach the positively recited engine and generator. Furthermore, the Office relies on Pleskach to teach control electronics. However, the control electronics of Pleskach **are not directed to** a "power electronics device" that has "the capability to modify and convert the electrical power to one or more of **selective** forms" as positively recited by independent claim 1. In fact, the control electronics of Pleskach are directed to "micro-electromechanical systems, or MEMS...[and] a MEMS combines a very small mechanical device...with an integrated circuit (IC)" (col. 1, lines 20-30 of Pleskach). Micro-electromechanical systems or MEMS of Pleskach are not "power electronics devices" as described in the originally-filed application. The Office is respectfully reminded that patent

application claims are interpreted consistent with the specification. *In re Yamamoto*, 740 F2d 1569, 1571 (Fed. Cir. 1984). Pursuant to the above authority, since the Office has failed to provide a combination of references that teach or suggest a positively recited limitation of claim 1, independent claim 1 is allowable.

Claims 6-12 and 21-27 depend from allowable independent claim 1, and therefore, are allowable for depending from an allowable independent claim.

For example, dependent claim 7 recites a "**gear box** coupled between the engine and the generator." Murray and Pleskach, singularly or in any combination, fail to teach or suggest a "gear box." An electronic search of the documents verifies that a gear box is not taught. Since the combination of art fails to teach or suggest the positively recited limitation of claim 7, claim 7 is allowable.

Moreover, dependent claims 11-12 recite to **flywheel(s)**. Murray and Pleskach, singularly or in any combination, fail to teach or suggest a "flywheel." An electronic search of the documents verifies that a flywheel is not taught. Since the combination of art fails to teach or suggest the positively recited limitation of claims 11-12, the claims are allowable.

Regarding the obviousness rejection against independent claim 15 based on the combination of Murray and Pleskach, claim 15 recites "the generator and producing an output of electrical power...the electrical power comprising a **selectable frequency output**." The Office has presented no

evidence of a **"selectable frequency output"** produced by a generator as positively recited by claim 15. Murray is provided to teach a generator. However, there is no teaching to a **selectable** frequency output by the Murray generator. Accordingly, since the art of record fails to teach or suggest a positively recited limitation of independent claim 15, independent claim 15 is allowable.

Claims 17-20 depend from allowable independent claim 15, and therefore, are allowable for depending from an allowable independent claim.

For example, dependent claim 18 recites "wherein the output of the electrical power comprises a **selectable voltage output**." The art of record fails to teach or suggest a "voltage output," and therefore logically, fails to teach or suggest a selectable "voltage output." In fact, an electronic search of Murray and Pleskach demonstrates "voltage" (and "V") is not mentioned in the documents. Accordingly, it is inconceivable that the art of record teaches or suggests "wherein the output of the electrical power comprises a **selectable voltage output**" as positively recited by claim 18. Again, pursuant to the above authority, since Murray and Pleskach fail to teach the positively recited limitation of claim 18, claim 18 is allowable.


Additionally, dependent claim 19 recites "coupling a power electronics device to the generator for **selectively modifying the output of the electrical power**." The art of record fails to teach or suggest a "power electronics device." For this reason alone, claim 19 is allowable. Furthermore, the art of record fails to teach or suggest **"selectively modifying the output of the**

electrical power." Of the combination of art, only Pleskach teaches a "continuous power output of 30 mW" (col. 6, lines 20-30 of Pleskach). "Continuous" power output taught by Pleskach is of course not a teaching to "**selectively modifying the output**" as positively recited by claim 19. For this additional reason, claim 19 is allowable.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Office's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such action.

Respectfully submitted,

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